

Application No. 09/875,323
Response dated May 16, 2005
Reply to Office Action dated March 15, 2005
Attorney Docket No. 3833-010852

REMARKS

The application has been amended to place it in condition for allowance or in better form for Appeal. As requested by the Examiner, claims 16-32 (without prejudice or disclaimer of that which is defined thereby) are cancelled as being drawn to non-elected subject matter. Applicant respectfully reserves the right to present such claims in later filed continuation or divisional applications. In view of the above amendments and the following remarks, Applicant respectfully requests entry of the present amendment and favorable reconsideration of the claims.

Claims 1-3 and 5-15 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,518,600 to Shaddock and Japanese Patent No. 52-15539 in view of U.S. Patent No. 3,849,383 to Fetscher et al., U.S. Patent No. 6,246,123 to Landers et al. and U.S. Patent No. 6,713,571 to Shimada. Applicant respectfully traverses this rejection.

Initially, Applicant respectfully submits that the finality of the rejection is improper. In particular, Applicant previously responded to a rejection of the claims by demonstrating that the documents cited as primary references applied in the rejection were not appropriate for citation, since the present application has a filing date which pre-dates the effective date of those cited documents. The rejection based on those cited documents was withdrawn in the March 15, 2005 Office Action, and a new

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rejection was presented. The March 15 Action, however, indicates that the Action is final because "the amendment necessitated the new ground of rejection presented in this Office Action". The prior amendment to the claims, however, addressed Section 112 rejections, which rejections were withdrawn in the March 15 Action. Accordingly, Applicant submits that the amendment did not necessitate the new ground of rejection, since the Amendment merely addressed and overcame prior Section 112 rejections. Applicant therefore submits that the finality of the present rejection is improper, and respectfully requests removal of the finality of the rejection.

Moreover, Applicant respectfully submits that the new ground of rejection based on Shaddock as set forth in the March 15 Action is improper and should be withdrawn in view of Applicant establishing a prior date of invention. To that end, Applicant attaches to the present communication a "DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. §1.131" executed by the present inventor, Dale Starkey. As set forth in the Declaration, Mr. Starkey provides evidence of a conception and reduction to practice of the present invention prior to the filing date of the Shaddock patent, namely November 17, 2000. In view of the evidence set forth in the attached Declaration, Applicant submits that Shaddock is not an effective document for citation as a reference, since the present invention was conceived and reduced to practice prior to the effective filing date of Shaddock. Since the rejection of the claims is based upon Shaddock as a primary reference, Applicant submits that the rejection is improper, and should be withdrawn.

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Furthermore, Shimada is cited as a secondary reference in the above rejection. Shimada, however, has a filing date of December 13, 2001, which is *after* the filing date of the present application, namely June 6, 2001. Accordingly, Shimada is not appropriate for citation against the claims of the to the present application. Since the rejection of the claims is based at least in part upon Shimada, Applicant submits that the rejection is improper and should be withdrawn for the reason given above.

Still further, when making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a prima facie case of obviousness. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Examiner can satisfy this burden only by showing an objective teaching in the state of the art, or knowledge generally available to one of ordinary skill in the art, which would lead an individual to combine the relevant teachings and/or the knowledge within the state of the art in the manner suggested by the Examiner. Id.; In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Action alleges that the Japanese patent espouses the pre-reaction before curing of an epoxy resin with a hardener and a luminescent pigment. The Action, however, fails to set forth any basis as to how the Japanese patent teaches, discloses, or suggests a composition which includes a phosphor material uniformly distributed throughout the composition. In fact, the cited excerpt from the Japanese patent fails in any way to disclose, teach, or suggest partial curing of the epoxy resin with a phosphor material uniformly suspended therein, as claimed in the present invention. Through such partial curing, such as increasing the viscosity of the resin with continued mixing,

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the phosphor material is substantially uniformly distributed throughout the composition. The Action fails to demonstrate any portion of the Japanese patent which teaches, discloses or even remotely suggests suspending a phosphor material within the composition during a partial curing to achieve a uniform distribution of phosphor material. Accordingly, a prima facie case of obviousness has not been established.

Moreover, the Japanese patent merely discloses a luminescent pigment compounded in an epoxy resin. Applicant has demonstrated through the Examples of the present application that merely combining a phosphor material within an epoxy resin and then partially curing the epoxy does not provide a composition with the phosphor uniformly distributed therethrough. In particular, Example 1 of the application demonstrates a molding composition in which a phosphor material was mixed with epoxy, anhydride and polyol components and then partially cured through B-staging. Example 2 of the application demonstrates a molding composition in which an epoxy was pre-reacted with a phosphor material suspended therein prior to B-staging. As noted at paragraph [0052] of the application, a comparison of the samples of Examples 1 and 2 demonstrate a uniform distribution of the phosphor material in the sample which was pre-reacted to suspend the phosphor within the epoxy compound as compared with the sample which included phosphor material but did not involve such a pre-reaction.

Even if the Japanese reference cited in the Action discloses a luminescent pigment compounded in an epoxy resin and heated, there is no disclosure of a uniform distribution of a phosphor material within the epoxy composition. As evidenced through

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Examples 1 and 2 of the present invention, without the pre-reaction while the phosphor material is suspended in the epoxy, for example by continuous mixing while increasing the viscosity in the pre-reaction stage, the final product produced through B-staging does not include a uniform distribution of the phosphor material. The Japanese reference as cited in the Action fails in any way to teach, disclose or suggest such a pre-reaction to suspend the phosphor in the epoxy.

The remaining references have merely been recited for their disclosure relating to specific hardeners and polyols. None of these secondary references, however, add to the deficiencies of the Japanese reference. Quite simply, Applicant has invented a composition which includes a uniform distribution of phosphor material, and the cited prior art, whether considered alone or in combination, fails in any way to teach, disclose or even remotely suggest such a composition achieved through partial curing while maintaining the phosphor suspended within the composition.

In view of the above amendments and remarks, Applicant submits that the rejection of the claims is improper. Accordingly, entry of the amendment, withdrawal of the rejection, and favorable reconsideration of the claims are respectfully requested.

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Any questions regarding this communication may be directed to
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Respectfully submitted,

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